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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,014	09/22/2003	Jiann-Hsing Chen	81623/LPK	1910
7590	05/06/2005		EXAMINER	
Paul A. Leipold Eastman Kodak Company 343 State Street Rochester, NY 14650-2201				ZACHARIA, RAMSEY E
		ART UNIT		PAPER NUMBER
				1773

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/668,014	CHEN ET AL.
	Examiner Ramsey Zacharia	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 February 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-46 is/are pending in the application.
 4a) Of the above claim(s) 40-46 is/are withdrawn from consideration.
 5) Claim(s) 33 is/are allowed.
 6) Claim(s) 1-32 and 34-39 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/11/2005</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claims 40-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11 February 2005.

Information Disclosure Statement

3. The second reference in the information disclosure statement filed 11 February 2005 has been lined through because U.S. Patent 6,846,441 was not issued to Chen et al. on 26 November 2002. It appears that the applicants intended to cite U.S. Patent 6,486,441. This reference was considered and has been made of record through its inclusion on attached form PTO-892.

Claim Rejections - 35 USC § 112

4. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claims 37 and 38 are rendered indefinite because it is unclear if the molecular weight recited in the claims is the number average molecular weight, weight average molecular weight, viscosity average molecular weight, etc.

Claim Rejections - 35 USC § 103

6. Claims 1-32, 34-36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meguriya (U.S. Patent 6,261,214) in view of Gervasi et al. (U.S. Publication 2002/0102410).

Meguriya teaches heat fixing roll comprising a organopolysiloxane composition containing a hollow filler (column 2, lines 7-12). The hollow filler has elasticity and is made of polymers of (meth)acrylonitrile, (meth)acrylate, or vinylidene chloride with inorganic particles attached to the walls thereof (column 2, lines 13-26). The hollow filler has a diameter of preferably up to 90 μm (column 2, lines 40-42). The preferred concentration of the hollow filler is as low as 0.5 parts by weight per 100 parts of silicone, i.e. approximately 0.5 wt% (column 2, lines 52-55). Conductive agents, such as carbon black, zinc oxide, aluminum oxide, and titanium oxide, may be added to the silicone (column 4, lines 55-57). Silica (i.e. a strength-enhancing filler particle) having a particle size of about 0.1-50 μm may be added to the silicone (column 4, line 64-column 5, line 2). In the embodiment of Example 1, about 5 wt% of silica is added to the composition (column 6, lines 8-17). A fluoro-resin layer, such as polytetrafluoroethylene, may be formed over the silicone layer (column 5, lines 41-45). The silicon is made by heating first at a temperature of about 100 to 150 °C, then at about 180 to 200 °C (column 5, lines 24-28). The silicone has a thermal conductively of as high as 5.0×10^{-4} cal/cm • sec • °C, i.e. about 0.12

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BTU/hr/ft/ $^{\circ}$ F (column 5, lines 29-31). The silicone layer has a preferred thickness of 0.2 to 50 mm, i.e. about 0.008 to 2 inches (column 5, lines 38-40). The preferred upper limit of the thickness of the fluoro-resin layer 50 μ m, i.e. about 0.002 inch (column 5, lines 63-65).

Meguriya do not teach the presence of a fluoro-thermoplastic polymer in the silicone layer.

Gervasi et al. is directed to a composition suitable for toner fusing members (paragraph 0002). The composition comprises an interpenetrating network of a polytetrafluoroethylene and a silicone (paragraph 0017). The interpenetrating the silicone with the polytetrafluoroethylene improves the film strength and non-swell characteristics of the resulting material (paragraph 0019).

One skilled in the art would be motivated to interpenetrate the silicone of Meguriya with the polytetrafluoroethylene of Gervasi et al. to improve the strength and non-swell-characteristics of the resulting roller.

Regarding claims 7 and 8, the amount of conductive agent added to the composition directly affects the conductivity of the silicone. That is, the amount of conductive agent added is a results effective variable. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the amount of conductive agent in the silicone, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2nd 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 17, 18, and 36, the temperature at which the material is made, the curing process, and the size of the particles from which the layer comprising a fluoro-thermoplastic polymer is made are all product-by-process limitations. When the prior art

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discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the resulting products appear to meet all the structural limitations of the product of claims 17, 18, and 34. Therefore, the burden is on the applicant to conclusively demonstrate that the product formed at a temperature of between about 230-260 °C, a product formed by curing with an electron-beam, and a product formed from using polytetrafluoroethylene particles of about 0.01-1 mm in diameter are different from that disclosed by the prior art.

Regarding claim 25, a thermal conductivity of 5.0×10^{-4} cal/cm • sec • °C is taken to read on approximately 0.2 BTU/hr/ft/°F.

Regarding claims 29 and 30, the Shore A hardness is a material property. Since the both the material claimed and that of the prior art are fluoro-thermoplastic polymers containing hollow particles they should have the same Shore A hardness.

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Allowable Subject Matter

7. Claim 33 is allowed for the reasons put forth in the Office action mailed 09 September 2004.

Response to Arguments

8. Applicant's arguments filed 11 February 2005 have been fully considered but they are not persuasive.

Regarding the 35 U.S.C. 112, second paragraph, rejection of claims 37 and 38, the applicants argue that it is well known in the polymer arts to disclose and recite size using molecular weight per se without further embellishment as a unit of measurement, citing U.S. Patent 4,820,693 as support.

This is not persuasive for the following reasons. Because high molecular weight polymers comprise a distribution of chains having different lengths, the molecular weights are reported as averages. The molecular weight of a high polymer is therefore a function of how the average is calculated. See the attached discussion on pages 8-10 in Cowie (Polymers: Chemistry and Physics of Modern Materials). In particular, Figure 1.1 on page 9 should be noted demonstrating how molecular weights of the same polymer sample can vary depending on the method by which the molecular weight average is calculated. The fact that U.S. Patent 4,820,693 refers only to molecular weight is immaterial since the polymers disclosed therein are relatively short and would not be considered high polymers. The molecular weights in U.S. Patent 4,820,693 are in the range of 1,000-6,000 as compared to the polymers discussed in Cowie (the numerical examples bridging pages 9 and 10 has molecular weight in the range of

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3.6-7.22 x 10⁵). The claimed range of molecular weights in the instant invention (50,000-800,000) are much higher than those of U.S. Patent 4,820,693 and within the range of the high polymers discussed in Cowie.

Regarding the art rejection, the applicants argue that the references teach different end results obtained with different starting materials, using different means. Meguriya uses an organopolysiloxane alone with no other polymer making up the continuous phase as opposed to Gervasi et al. in which an IPN of PTFE and polysiloxane is used. Gervasi et al. teach particular starting materials and process conditions including the use of an organic liquid. The applicants argue that one skilled in the art would not be motivated to combine the references because the references fail to disclose or suggest how to combine their teachings, for example how the Meguriya process could be modified to employ the organic liquid of Gervasi et al.

This is not persuasive for the following reasons. Both Meguriya and Gervasi et al. are concerned with the same end result: forming a resilient coating layers on rollers for applications such as fuser members. Both Meguriya and Gervasi et al. appear to use the same type of silicone rubber as their starting material. Meguriya uses a peroxide curing silicone, preferably containing alkenyl groups (column 2, line 63-column 3, line 9) while Gervasi et al. also uses a silicone containing alkenyl groups cured by peroxide (paragraphs 0021-0022). And because both Meguriya and Gervasi et al. are directed to forming the same product (a cured resilient layer on a rigid core), the teachings of Gervasi et al. explicitly demonstrates a process by which this product may be formed even when an organic liquid is present in the coating composition.

The applicants further argue that even if the combination of Meguriya and Gervasi et al. could be made, it would still not result in the applicants' invention because the layer is a

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fluoropolymer material. By contrast, Meguriya is a silicone rubber layer and modifying it to include polytetrafluoroethylene would not make it a fluoropolymer layer.

This is not persuasive because an IPN of silicone and polytetrafluoroethylene includes a fluoropolymer material (polytetrafluoroethylene). The claims as written require the resilient layer to have a fluoropolymer material, however, the composition of the resilient layer is not closed to only fluoropolymer materials. For example, in addition to the fluoropolymer material, the resilient layer also contains microsphere particles which may be formed of polymers other than fluoropolymers (see claim 19) and solid filler particles which may be formed of materials that are not polymers at all (see claim 3).

Regarding claims 31 and 32, the applicants argue that the claims recite a pressure roller while Meguriya and Gervasi et al. are directed exclusively or predominantly to heat fixing rolls.

This is not persuasive because Meguriya taken in view of Gervasi et al. teach a roller that meets all of the structural limitations of instant claims 31 and 32. The designation of "pressure roller" is merely an intended use of the roller that does not add any structural features or limitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
Tech Center 1700